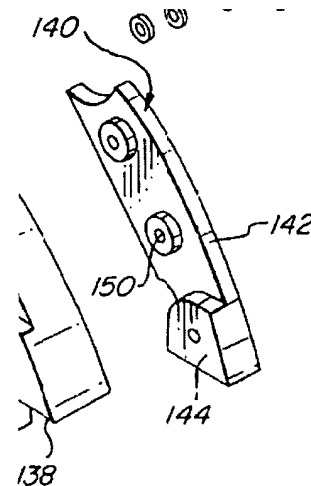
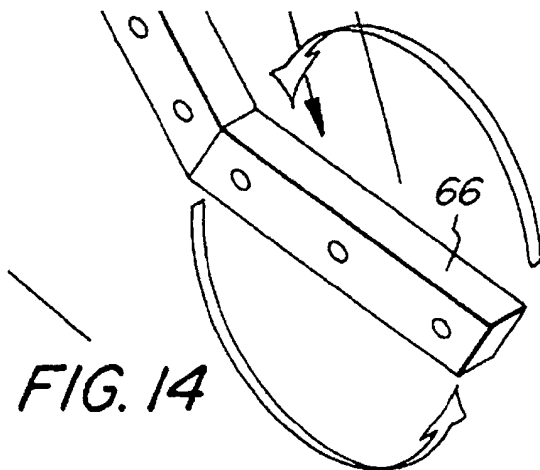


### REMARKS

Claims 1-22, 40-49, 51, 53, and 55 were pending after entry of the August 1, 2006 amendment. Claims 1, 5, and 14 are amended. Applicants request reconsideration and allowance of pending claims 1-22, 40-49, 51, 53, and 55 in view of the following remarks.

Claims 1-22, 40-49, 51, 53, and 55 were rejected under 35 U.S.C. § 103 as obvious over U.S. Patent No. 5,992,023 ("the '023 patent"). Applicants respectfully traverse this rejection. Claims 1, 5, 14 each recite, among other things, an "indexable wear plate/piercing tip insert" with "a metal tip portion disposed at each of said two ends, each said tip portion protruding laterally with respect to a surface of said central region." Claim 42 similarly recites, among other things, an "indexable wear plate/piercing tip insert" with "metal tip portion disposed at each of said two longitudinal ends, each said tip portion protruding laterally with respect to a surface of said central region." The Examiner asserts that because the '023 patent discloses a "a wear plate/piercing tip insert 140 having one cutting tip 144" and also discloses indexable blade insert members 66, 116, it would have been obvious to make the one-sided piercing tip 140 indexable by adding a second cutting tip "so that both ends of the wear plate/pierce tip can be used to reduce the spare part of the wear plate/pierce tip." August 25, 2006 Office Action, p. 3.



**The '023 Patent, FIGS. 10 and 14 (excerpted)**

Applicants traverse the Examiner's assertion that it would have been obvious to one of ordinary skill in the art, in view of the '023 patent, to add a second cutting tip 144 to the piercing tip 140 to make it indexable.

First, the '023 patent includes no suggestion to add an additional nose piece 144 to an opposite side of the piercing tip 140 to make the piercing tip 140 indexable. See the '023 patent,

col. 6, lines 51-63. The indexability of the blade insert member 66 in the '023 patent would not have made it obvious to make the disparate one-sided piercing tip 140 indexable. The Examiner improperly equates the known indexability of a blade insert member 66 with the suggestion to make a wear plate/piercing tip 140 indexable. In fact, blade insert members 63, 66, 114, 116 in the '023 patent are categorically different than the wear plate/piercing tip 140 in the '023 patent. Blade insert members 63, 66, 114, 116 have simple geometric configurations whose simple shapes lend themselves to indexability. For this reason, blade insert members have been indexable for years. In contrast, piercing tips such as the piercing tip 140 in the '023 patent have more complex shapes. For example, the piercing tip 140 in the '023 patent has several protrusions (i.e., nose piece 144 and bosses (surrounding apertures 150)). Such protrusion(s) categorically distinguish piercing tips 140 from simple blade insert members 64, 66, 114, 116 in the eyes of one of ordinary skill in the art. The indexability of the specifically-claimed wear plate/piercing tip insert of the present invention is simply not known or rendered obvious by the prior art.

The '023 patent's failure to make the Examiner's proposed modification obvious is further emphasized by the '023 patent's glaring failure to teach or suggest making the piercing tip 140 indexable, despite including detailed discussions and figures disclosing the indexability of the blade insert members 64, 66, 114, 116. *See* the '023 patent, FIGS. 4, 13, & 14, and col. 7, lines 19-44. If the Examiner's proposed modification to the piercing tip 140 was obvious based solely on the '023 patent, the '023 patent would have mentioned or suggested such a modification in view of the '023 patent's focus on indexability. The '023 patent suggests no such modification to the piercing tip 140 because such a modification was not suggested or contemplated by the '023 patent or obvious to one of ordinary skill in the art in view of the '023 patent.

Second, the Examiner's proposed combination is improper because it relies on impermissible hind sight. Applicants submit that the Examiner's rationale for applying the indexability of the blade insert member 66 to the piercing tip 140 in the '023 patent comes directly from the Applicants' present application, rather than the '023 patent or any prior art teaching.

Third, the Examiner's proposed modification to the piercing tip 140 of the '023 patent was non-obvious because it would have eliminated the "rhino horn" (identified by an added arrow in the below copy of FIG. 10 of the '023 patent) in the shears shown in the '023 patent. A "rhino horn" is a tine on a front, upper part of an upper jaw of a shears.

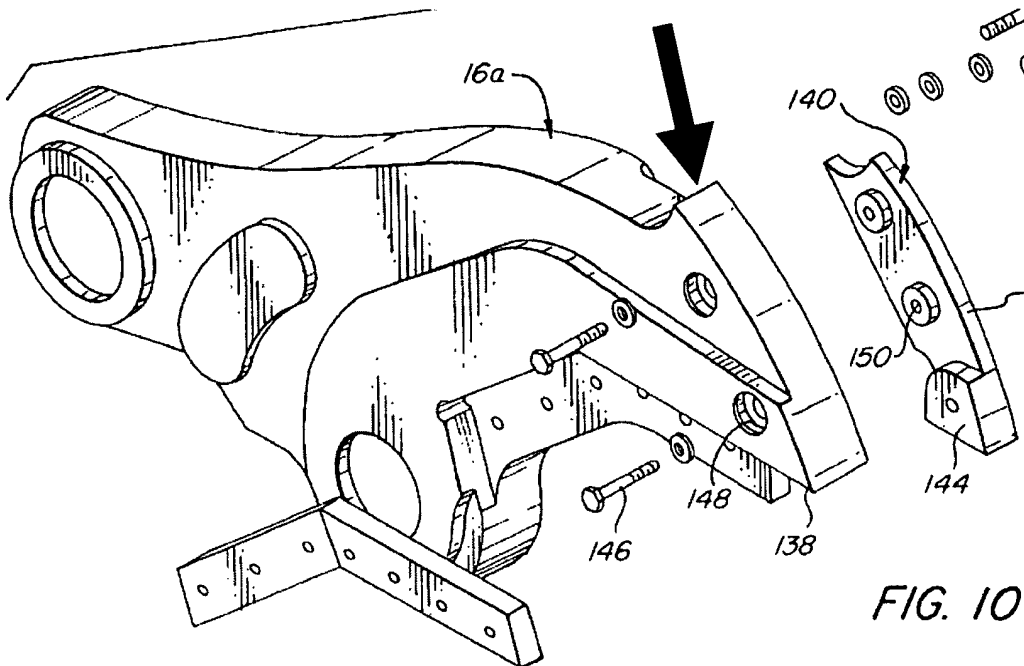


FIG. 10

**The '023 Patent (Excerpt; arrow added)**

A shears operator uses the rhino horn to manipulate material (e.g., to better position material to be sheared, to move material, to remove interfering debris, etc.). In the shears shown in FIG. 10 of the '023 patent, the rhino horn (not numbered) is formed by an upper part of the upper jaw 16 and an upper part of the piercing tip 140. Adding a second nose piece 144 to the piercing tip 140, as proposed by the Examiner, would have interfered with or eliminated the rhino horn. Accordingly, the '023 patent, as understood by one of ordinary skill in the art, teaches away from the Examiner's proposed modification because it would have interfered with or eliminated an advantageous rhino horn of the shears shown in the '023 patent.

Fourth, the commercial success of the claimed invention objectively establishes its non-obviousness. MPEP § 716.03. "Under *Graham*, objective evidence of nonobviousness includes commercial success... When present, such objective evidence ***must be considered.***" *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 960 (Fed. Cir. 1986) (emphasis added). "[E]vidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art is not." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983).

To establish commercial success, Applicants must establish A) the commercial success of a product embodying the invention, and B) "a nexus ... between the sales and the merits of

the claimed invention,” i.e., that the commercial success was “a direct result of the unique characteristics of the claimed invention.” *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996). The attached declaration of Clayton Sederberg demonstrates both of these requirements. Specifically, the MSD Saber series of shears include the piercing tip recited in claims 1, 5, 14, and 42 of the present application. *See Sederberg Decl.*, ¶ 3. The sale of over 500 such MSD Saber series shears demonstrates the commercial success of the invention-embodiment product. *See Sederberg Decl.*, ¶ 4. The nexus between the commercial success and the claimed invention is demonstrated by the fact that Stanley was not able to successfully commercialize shears shown in FIG. 10 of the commonly owned ‘023 patent with a non-indexable piercing tip, but did successfully commercialize the shears with the indexable piercing tip according to the present invention. *See Sederberg Decl.*, ¶¶ 2-5.

For these reasons, Applicants respectfully submit that the Examiner’s proposed modification of the piercing tip in the ‘023 patent would not have been obvious to one of ordinary skill in the art. Applicants therefore respectfully request the withdrawal of the obviousness rejection of the present claims.

Applicants further specifically traverse the Examiner’s rejection of claim 40, which recites, among other things, that “the at least one boss or dowel comprises a first boss or dowel that is disposed at the pivot axis.” In contrast, the ‘023 patent fails to suggest or disclose such positioning of at least one boss or dowel at the pivot. The failure of the ‘023 patent to suggest such positioning is demonstrated by the fact that none of the indexable blade inserts disclosed in the ‘023 patent include such a boss or dowel. Accordingly, the ‘023 patent fails to disclose or suggest the combination of recitations in claim 40. Claims 41, 43, and 49 are patentable for similar reasons.

Applicants further specifically traverse the Examiner’s rejection of claim 46, which recites, among other things, “a first notch [that] extends into the central region from the first generally planar edge surface,” and “a second notch [that] extends into the central region from the second generally planar edge surface.” The ‘023 patent does not disclose or suggest such a combination of recitations.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is requested.

If the Examiner has any questions or suggestions that will further prosecution of this application, the Examiner is encouraged to contact the undersigned at the below-listed telephone number.

JOHNSON ET AL. -- 10/697,554  
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Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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